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In re Application of
Cynthia Cowgill et al
Serial No.: 08/477,984
Filed: June 7, 1995
Attorney Docket No.: 1087.001

: PETITION DECISION

This is in response to applicant's petition under 37 CFR 1.181, filed March 1, 2000, requesting reopening of prosecution based on the examiner's failure to timely act.

BACKGROUND

A review of the file history shows that the examiner mailed a Final Office action to applicants on December 4, 1998, setting a three month shortened statutory period for response and setting forth three new rejections based on a new reference, Halloran, in combination with references already of record. Halloran issued January 27, 1998 (filing date of parent being September 8, 1994), and was likely not available at the time the previous Office action was prepared on March 17, 1998. Whether the new rejections were necessitated by applicants' amendments to the claims is not stated. Applicants replied on June 4, 1999, requesting and submitting the fee for a three month extension of time, with an amendment consisting of argument and an affidavit under 37 CFR 1.131 swearing behind the Halloran reference. A Notice of Appeal was concurrently filed with the appeal fee. Applicants also conducted a telephone interview with the examinr on June 25, 1999, to ascertain the disposition of the amendment and affidavit. At that time, no decision or evaluation had been completed even though the examiner had received the application approximately two weeks earlier. Applicants state that they continued to call the Office and examiner regularly to determine the status of the application and the amendment disposition without success until an Advisory Action was mailed on January 13, 2000. Immediately prior to this applicants were constrained to file an Appeal Brief based on the Final Office action without regard to the subsequently filed amendment. The Advisory action indicates that the amendment filed June 4, 1999, has been entered (even though the paper has written on it "Do Not Enter"), but that the affidavit is insufficient to overcome the reference for a number of reasons explained by the examiner. Applicants' then filed this petition to reopen prosecution based on lack of opportunity to address the outstanding issues in the file.

DISCUSSION

Prosecution before the Office of pending applications is to be done expeditiously. It is general Office policy to reply to an applicants' communication to the Office within two months of receipt

pplus processing time and to reply to amendments submitted after a Final Office action within 30 days of receipt, including processing time. With respect to the amendment submitted on June 4, 1999, in reply to a Final Office action, this was not done. It appears that the examiner delayed more than seven months after receipt of the amendment and affidavit despite repeated requests by applicants for action thereon before making a decision denying applicants' arguments as insufficient. However, even more incorrect was the examiner's application of a new reference not previously available in a Final Office action without any indication that the reference application was necessitated by amendments to the application. A review of those amendments does show that new limitations were added, but not that such limitations could not have been reasonably predicted by the examiner in view of the art previously cited and applied. In fact the amendments to claim 1 merely define the specific yeast cells which are used and expressly limit the cation exchange to a single step although such exchange appears only once in the claim suggesting that it is only a single step anyway. In view of this, the finality of the Office action of December 4, 1998, was improper.

With respect to the evaluation of the affidavit submitted with the amendment of June 4, 1999, the examiner is correct in the evaluation. Applicants present what appears to be a process agenda for the process claimed herein. However, the process consists of seven steps whereas the claimed process consists of only four steps. Further, the second and third sheets have been so redacted as to present meaningless information. It is unclear whether the statement at the top of page three applies to information from the previous page on to information subsequent to the statement. Further, such statement does not evidence constructive reduction to practice or even a positive conception, only mere speculation. Mere speculation is insufficient to overcome a reference under 37 CFR 1.131.

DECISION

Applicant's petition is **GRANTED**. The finality of the last Office action is withdrawn. The reply filed June 4, 1999, will be considered as a reply to a non-final Office action.

The Notice of Appeal will be withdrawn until such time as the application has been properly finally rejected. A new Notice of Appeal may be filed at that time without additional fee. Should this application be allowed without the necessity of an appeal, refund of the fees for the Notice of Appeal and Appeal Brief may be requested.

The application will be returned to the examiner for further consideration, including all arguments presented in the Appeal Brief which will be considered a supplemental reply to the Office action of December 4, 1998, not inconsistent with this decision.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600/2900, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-5408.

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